

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-23, 27-32 and 38-41 are pending. The amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry. It was indicated on page 14 of the Action by the Examiner that claim 37 would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Instead of rewriting claim 37, Applicant has chosen to amend the independent claims to specify that variants have at least 95% identity with SEQ ID NO:2 over the entire length of the sequence and at least one of the indicated mutations.

Applicant submits that the amendments to the claims moot the remaining written description and enablement rejections under Section 112, first paragraph.

35 U.S.C. 112 – Written Description

The specification must convey with reasonable clarity to persons skilled in the art that applicant was in possession of the claimed invention as of the filing date sought. See *Vas-Cath v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). But the Patent Office has the initial burden of presenting evidence or a reason why persons of ordinary skill in the art would not have recognized such a description of the claimed invention in the original disclosure. See *In re Gosteli*, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Claims 1-23 and 33-41 were rejected under Section 112, first paragraph, as allegedly “failing to comply with the written description requirement.” It was further alleged, “The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Applicant traverses.

In order to further the prosecution of this application and without prejudice to the future prosecution of other applications, the independent claims are amended to require the variants have at least 95% identity to SEQ ID NO: 2 over the entire length of the sequence in (c). The polypeptide must also have carbohydrate processing enzymatic activity. Polypeptides falling within the scope of the claims are therefore well defined by

the limitations of the independent claims, which reference both their biological activity and their chemical structure (i.e., the amino acid sequence). Based on case law and the Patent Office guidelines, the teachings in Applicant's specification shows that he was in possession of the claimed invention.

Withdrawal of the written description rejection is requested.

35 U.S.C. 112 – Enablement

The Patent Office has the initial burden to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04, and the cases cited therein. It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. *In re Marzocchi*, 169 USPQ 367, 370 (C.C.P.A. 1971). Specific technical reasons are always required. See M.P.E.P. § 2164.04.

Claims 1-23 and 33-41 were rejected under Section 112, first paragraph, as it was alleged that the specification “does not reasonably provide enablement for any carbohydrate processing or degrading or synthesizing enzyme or any variant of SEQ ID NO:2 or any mutation in SEQ ID NO:2 at any position or any mutation at any position equivalent to M439 or any polypeptide having one or more position substituted by any amino acid.” Applicant traverses.

As indicated above, the independent claims are amended to require the variants to have at least 95% identity to SEQ ID NO: 2 over the entire length of the sequence in (c). The polypeptide must also have carbohydrate processing enzymatic activity. Based on case law, the teachings in Applicant's specification would enable persons skilled in the art to make and use the claimed polypeptides without undue experimentation.

Withdrawal of the enablement rejection is requested.

Conclusion

Having fully responded to all of the pending objections and rejections contained in this Office Action, Applicant submits that the claims are in condition for allowance and

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earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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